

REMARKS

Claims 1-12 are currently pending, with claims 1, 5 and 7 being the independent claims. Reconsideration of the application is respectfully requested.

In the July 27, 2006 Office Action, independent claims 1, 5 and 7, and dependent claims 2-4, 6, and 8-11 were rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 5,590,125 (“*Buhrmann*”) in view of U.S. Patent No. 5,371,738 (“*Moelard*”), and further in view of U.S. Patent No. 6,571,096 (“*Plunkett*”). For the reasons that follow, it is respectfully submitted that all claims of the present application are patentable over the cited references.

The Examiner acknowledges (Office Action, pg. 3) that the combination of *Buhrmann* and *Moelard* differs from the claimed invention in that they fail to teach or suggest “(b) changing the service selection offered to a mobile station by the communications system in response to an indication of the arrival of the mobile station in said localized service area, which indication is a message generated by said mobile station”. *Plunkett* has been cited by the Examiner to cure this deficiency of *Buhrmann* and *Moelard*. However, *Plunkett* does not qualify as prior art against the present application.

The present application has a filing date of October 17, 2000. On March 23, 1999 Applicant filed International application no. PCT/FI99/00227, which claimed priority of Finnish application no. 980654 filed March 23, 1998. On September 22, 2000, Applicant filed a National Phase application in the USPTO. The submission included a copy of the International application that was filed in English. A copy of the receipt stamped by the USPTO to acknowledge receipt of the foregoing papers is attached hereto.

In order to perfect a claim for priority benefit, it is necessary to submit a certified English translation of the priority document. It is hereby stated that the International application was filed in English and is identical to the text of the Finnish priority application. Therefore, the International application, which has already been submitted, serves as the translation of the priority application. Thus, the claim for priority benefit has been perfected and the present application is entitled to benefit from the priority date of March 23, 1998.

Plunkett has a filing date of November 10, 1999, and an earliest priority date of November 12, 1998 that is subsequent to the March 23, 1998 priority date of the present application. Therefore, *Plunkett* does not qualify as prior art against the present application. Consequently,

independent claims 1, 5 and 7 remain patentable over *Buhrmann* and *Moelard*, since *Plunkett* does not qualify as prior art against the present application.

In any event, even assuming *arguendo* that *Plunkett* qualifies as prior art, the claimed invention would still not be achieved by the combination of *Buhrmann*, *Moelard* and *Plunkett*. *Plunkett* relates to a method for preventing toggling between the different zones of a wireless communication system (see col. 1, lines 18-19).

Plunkett (col. 2, lines 56-59) states, “depending upon internal preferences programmed within it, the mobile unit prefers to access one zone over another zone ... [for example, the] ... mobile unit prefers to access the services of zone A”. *Plunkett* thus teaches that the mobile unit prefers to access the services of zone A over that of other zones.

Plunkett (col. 2, lines 60-64) states, “the mobile unit will use zone B, the only available zone, in cell 1. In moving from the outer cells of the diagram to the inner cells, the mobile unit will continue to use zone B services in cell 2. This is because the cells surrounding the inner most cell are designated as hysteresis cells for zone A”. *Plunkett* (col. 2, line 65 thru col. 3, line 5) states, “the mobile unit will not seek the services associated with zone A until it has reached the inner most cell (cell 3), the zone A cell without hysteresis. This same mobile unit, in moving from the inner most cell (cell 3) to the outer cells (cells 4 and 5) will continue using zone A in cell 4. This is because the mobile unit prefers to access zone A. The mobile will not switch to zone B services until it has reached cell 5, which supports only zone B services”. *Plunkett* thus teaches reasons associated with why the mobile unit will switch from using zone A to obtain services.

Plunkett (col. 4, lines 36-34) states, “there may be circumstances where a mobile unit, at power up, can access several zones. There are various way to accommodate this situation. The mobile unit might prefer zones for which the hysteresis parameter is not set. In this case, the mobile unit uses a zone having hysteresis and the power up parameter only if all zones have the hysteresis parameter set”. *Plunkett* thus clearly teaches that it is the mobile unit that decides which service zone is used.

However, a necessary condition that must occur before the mobile unit can even begin to make such a decision is that several service profiles must be available. In other words, the location-dependent service server of *Plunkett* does not change the service selection offered to the mobile station in response to any message that originates from a mobile unit, i.e., the location-

dependent service server ensures that all possible service selections are available at all times. It is then up to the mobile unit to decide which service to select from the wide variety of zone-specific service profiles that is offered. Put differently, *Plunkett* fails to teach or suggest "changing the service selection offered to a mobile station by the communications system in response to an indication of the arrival of the mobile station in [a] localized service area, which indication is a message generated by [the] mobile station", as recited in independent claim 1. Consequently, independent claim 1 is patentable over the combination of *Buhrmann*, *Moelard* and/or *Plunkett*, even assuming *arguendo* that *Plunkett* qualifies as prior art. For this additional reason, reconsideration and withdrawal of all the rejection under 35 U.S.C. §103 are in order, and a notice to that effect is earnestly solicited.

Independent claim 5 is an apparatus claim associated with system of in claim 1. Independent claim 7 is the method claim associated with the system of independent claim 1. Accordingly, independent claims 5 and 7 are patentable over the combination of *Buhrmann*, *Moelard* and *Plunkett* for the reasons discussed above with respect to independent claim 1.

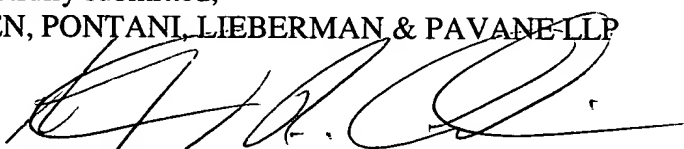
In view of the patentability of independent claims 1, 5 and 7, for the reasons set forth above, dependent claims 2-4, 6 and 8-12 are all patentable over the cited prior art.

Based on the foregoing amendments and remarks, this application should be in condition for allowance. Early passage of this case to issue is respectfully requested.

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,
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In re National Phase PCT Application of
Petteri PUTKIRANTA et al.
International Appl. No.: PCT/FI99/00227
International Filing Date: March 23, 1999
For: Method And System For Using Location Dependent Services In A
Cellular Radio System

09/646802

By Express Mail No. EL628565445US with the following enclosures:

1. Transmittal ltr. (2x)
2. General Authorization (2x)
3. Int'l appln., PCT Publication Sheet & sheets of drawings
4. Verified English translation of int'l appln. & amended pgs. of Int'l Prel. Exam. Report
5. Int'l Prel. Exam. Report w/ amended pgs.
6. Letter w/ Proposed Drawing Changes, sheet(s) of drawings (Figs. -)
7. Unexecuted Combined Declaration Power of Attorney (p.)
8. Verified Statement Claiming Small Entity Status
9. Written Opinion + translation thereof
10. Int'l Search Report
11. Preliminary Amendment
12. PCT Request
13. PCT Demand
14. Information Disclosure Statement, PTO 1449 & cited references ()
15. Check for \$840.00 for filing fee
16. Return receipt postcard

KINDLY DATE STAMP AND RETURN
TO ACKNOWLEDGE RECEIPT

09/02/00

4/4 Rec'd PCT/PTO 22 SEP 2000